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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,724	02/26/2004	John S. Fox	LIG 0002P	6809

7590 02/26/2007
John S. Fox
684 Poinsettia Park South
Encinitas, CA 92024

EXAMINER

PENG, CHARLIE YU

ART UNIT	PAPER NUMBER
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2883

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/788,724

Applicant(s)

FOX, JOHN S.

Examiner

Charlie Peng

Art Unit

2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3-10, 12-17, 20 and 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 11, 18, 19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: applicant indicated the instant application is related to two other applications filed in the first paragraph. Since both the two other applications have been assigned USPTO serial numbers, their actual serial number should be inserted into the first paragraph.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Election/Restrictions

Applicant's election with traverse of Specie A in the reply filed on 10 July 2006 is acknowledged. The traversal is on the election restriction requirement of Species A, D and E only. The traversal is on the ground(s) that Species A, D and E are all functional elements of applicant's invention in providing wavelength control, even illumination and light intensity control. Applicant argues "invention will not work properly" without the three functional elements. This is not found persuasive because the basis of the restriction requirement was Species A, D and E each has mutually exclusive components, and the fact applicant admits each specie serves a different function within the apparatus as a whole further strengthens examiner's position. Whether or not applicant's invention is a combination of the three will be decided during the course of

Art Unit: 2883

prosecuting the instant application. If applicant believes each of the species would *not* function by itself or the invention is indeed a combination of *all* three species, applicant should re-write the claim(s) to truly represent his invention instead of several non-functional components of the invention.

If applicant believes this assertion is incorrect, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-10, 12-17, 20 and 22-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on 10 July 2006 (addressed above).

Claims 1, 11, 18 and 21 link Species A, B, C and D. The restriction requirement is subject to the nonallowance of the linking claim(s). Upon the indication of allowability of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116;
amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 11, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,883,952 to Sander in view of U.S. PGPub 2004/0090671 to Gilbert. Sander teaches an apparatus for illuminating a viewing field by two light sources and a method of using the same comprising:

a specimen 18;

a first light source 1 adapted to emit a first beam of light along a first beam path in a first light guide 7;

a second light source 2 adapted to emit a second beam of light along a second beam path in a second light guide 8;

a combining flexible light guide 9 is provided and is adapted to collimate the first and second beams into a unified beam which is guided to a separating flexible light guide splitter which is adapted to divide the unified beam into at least two beams directed to a light output of a microscope 13 and a handpiece 16 which may be fixedly attached to the microscope;

the flexible light guides could be configured as a dual flexible light guide, as shown in Fig. 2;

and wherein the two light sources may be adapted to emit different wave spectra (i.e. different wavelength and color) and/or are interchangeably arranged. (See at least Fig. 1 and description.)

Since a viewing field is illuminated, one or more viewing axes must exist between the viewing field and one or more viewers/observers.

Sander further teaches that the use of flexible light guides (also referred to as optical fiber bundles) makes it possible to deliver light in relatively collimated fashion while focusing the majority of the light onto those locations that are to be illuminated. Further, this is possible while positioning heat-generating lamps remotely from the specimen to be illuminated. A common example of such a flexible light guide is called a "multi-arm *cable* light guide." (col. 1, lines 25-33)

Sander is silent on the presence of a stage supporting the specimen.

Gilbert teaches an optical observation system for microscopy or macroscopy operation having an XYZ stage (8a, 8b), movable in motorized fashion, on which a sample (specimen) to be examined is placed. Since the Sander reference and the Gilbert reference are of analogous arts in apparatus for examining samples and specimens, the purpose of using stage would have been recognized in the pertinent art of Sander's invention. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teachings of Sander by adding a stage to support the specimen for the motivation of securing or allowing precise focusing movements of the specimen.

With specific reference to claim 21, the two outputting light sources 13, 16 can be considered to form a third illuminating source in combination.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see form PTO-892 for additional references cited.

Applicant is welcomed to contact the examiner before responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlie Peng whose telephone number is (571) 272-2177. The examiner can normally be reached on 9 am - 6 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2883

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cyp



Frank G. Font
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